

The Office action identified the application as containing two (2) patentably distinct species of the claimed invention. Specifically, the Office action required an election of species between figure 4 (Species 1) and figure 6 (Species 2).

As set forth in detail below, without denying that the claims are patentably distinct, applicant traverses this election requirement. Subject to this traversal and in accordance with the requirements of 37 C.F.R. § 1.143, applicants hereby provisionally elect Species 1 for further prosecution in this application. Claims 1 and 4 read on Species I. Claims 1 and 4 are also generic to both species. Reconsideration and withdrawal of the restriction requirement is, however, requested in view of the following remarks.

It is respectfully submitted that the examiner has not met the burdens required to issue a proper restriction requirement. The M.P.E.P. clearly and unequivocally states that there are two criteria which *must* be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803). As explained below, the Office action fails to meet either of these two required criteria. Accordingly, the restriction requirement is procedurally improper and must be withdrawn.

M.P.E.P. § 808 sets forth an examiner's burden under the first required criteria of making a restriction requirement. Specifically, M.P.E.P. § 808 states: "[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as*

*claimed* are either independent or distinct; and (B) the reasons for insisting upon the restriction therebetween....” MPEP § 816 expounds upon this requirement:

The particular reasons relied upon by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. *A mere statement of conclusion is inadequate.* The reasons upon which the conclusion is based should be given.

(emphasis added).

The Office action does not meet this requirement. Instead, the Office action conclusorily states that “this application contains claims directed to the following patentably distinct species of the claimed invention: species 1, figure 4; species 2, figure 6” and does not provide any reason for such a conclusion. Accordingly, the restriction requirement fails to meet the first criteria of MPEP § 803 because it fails to provide any reasoning whatsoever as to why the inventions are distinct or independent. Therefore, on this basis alone, the requirement for election must be withdrawn.

The second requirement that a restriction requirement must meet under MPEP § 803, is a showing that a serious burden will be placed on the examiner if restriction is not required. “For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” (M.P.E.P. § 803).

In this instance, although the Office action identifies figures that the examiner believes to reflect patentably distinct species, it fails to show that the alleged species are separately classified, have a separate status in the art, or require different fields of search. Indeed, the Office action makes absolutely no effort to show a serious burden would be placed on the Examiner if restriction were not required. Thus, it is clear that the Office action also fails to address the second required criteria for restriction set forth in the M.P.E.P. In view of the following mandate, this failure to address the second required criteria for issuing a restriction requirement is particularly egregious:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). All of the claims of this application can be examined together without serious burden on the examiner. Therefore, the Office must examine it on the merits irrespective of whether it includes claims to distinct or independent inventions.

From the foregoing, it is plainly evident that the Office action fails to meet the criteria for issuing a restriction requirement. In particular, the Office action fails to provide even a shred of evidence that (1) the inventions are independent or distinct as claimed; or, (2) that there would be a serious burden on the examiner if restriction is not required. Failure to meet either of these criteria renders a restriction requirement improper. Failure to meet both of these criteria renders a restriction requirement unconscionable. Accordingly,

the applicant respectfully submits that the requirement for restriction must be withdrawn.

As demonstrated above, the Office action fails to meet its burdens for requiring restriction. Accordingly, as a procedural matter, the restriction requirement must be withdrawn. Moving beyond the procedural failures, to the substance of the restriction requirement, it is readily apparent that there is still another reason that the restriction requirement must be withdrawn. The MPEP unequivocally states, “Claims to be restricted to different species, must be mutually exclusive.” MPEP § 806.04(f). The MPEP goes on to expound on this point by explaining: “The general test as to when claims are restricted ... to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not for the first.” *Id.* In the application at issue, while independent claims 2 and 5 are directed toward limitations found only in the second alleged species (i.e., figure 6), independent claims 1 and 4 do not recite any limitations that are not present in both alleged species (i.e., in figures 4 *and* 6). Accordingly, it is clear that independent claims 1, 2, 4 and 5 are not mutually exclusive under the MPEP’s general test quoted above. Accordingly, it is clear that those claims must be examined together.

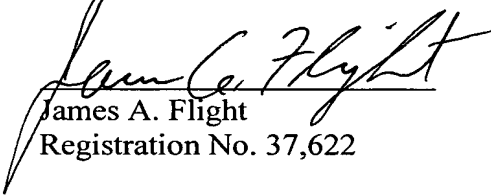
The Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required during the pendency of this application under 37 CFR 1.16 or 1.17 to Deposit Account No. 13-2855. A copy of this paper is enclosed.

Please refund any overpayment to Grossman & Flight, LLC's deposit account number 50-2455.

Respectfully submitted,

GROSSMAN & FLIGHT, LLC  
Suite 4220  
20 North Wacker Drive  
Chicago, Illinois 60606  
(312) 580-1020

By:

  
James A. Flight  
Registration No. 37,622

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